REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-15, 17-19, 21-23, and 25 are presently active in this case, Claims 3, 14, 18, and 22 having been amended and Claims 16, 20, and 24 having been canceled without prejudice or disclaimer by way of the present Amendment. Care has been taken such that no new matter has been entered by the amendments set forth herein.

The Applicants respectfully request entry of the amendments set forth herein as the amendment to Claim 3 merely corrects a minor typographical informality, and the amendments to Claims 14, 18, and 22 incorporates the subject matter of dependent Claims 16, 20, and 24, respectively, which were previously considered, with the addition of a new term.

In the outstanding Official Action, Claims 1-4, 6, 7, 9, 10, and 12-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (U.S. Patent No. 6,034,832) in view of Berman et al. (U.S. Patent No. 6,502,194). Claims 5, 8, and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. in view of Berman et al. and further in view of Epstein (U.S. Patent No. 6,601,046). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable

expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent Claims 1, 3, 4, 14, 18, and 22.

Claim 1 of the present application recites an information processing apparatus comprising, among other features, recording means, storing means for storing information regarding each track of the contents as recording history information, means for determining whether a track on a first recording medium was previously recorded or not by the recording means based on the recording history information, and display means for displaying information regarding a track that was not previously recorded as determined by the determining means, wherein the display means initially indicates the track that was not previously recorded as being selected for recording by the recording means from the first recording medium to a second recording medium. Similar features are recited in Claims 3 and 4. Claims 14, 18, and 22 recite, among other features, selecting means, a selecting step, or code for selecting that initially, automatically selects portions of the contents of the first recording medium for recording that do not have recorded history information present in the apparatus. The Applicants submit that the cited reference, either when taken singularly or in combination, fail to disclose or suggest the above features.

By way of illustration and not limitation, the present application advantageously provides an invention in which an audio recording managing unit (101) searches audio recording history information in stored memory, and judges whether or not audio recording

history of each of the tracks of a CD exist in the memory. (See step S4 in Figure 4 and corresponding description in the specification.) Thus, the apparatus is able to determine whether the tracks have previously been recorded to the apparatus. The audio recording managing unit (101) is configured to cause the graphical user interface (GUI) unit (100) to check boxes of unrecorded track(s) in the display list thereof. The checked items in the check boxes (224a-224h) are used to determine the content that will be recorded. Such features can prevent the user from accidentally recording track twice. Such features are not disclosed or suggested in the cited references.

The cited references, either when taken singularly or in combination, fail to disclose or even suggest a display means that initially indicates a track that was not previously recorded as being selected for recording by a recording means from a first recording medium to a second recording medium, as variously recited in Claims 1, 3, and 4 of the present application. The Official Action notes that the Ichimura et al. reference fails to disclose what information is displayed on the display thereof. (See page 3, lines 8-9, of the Official Action.) The Official Action supplements this deficiency with a teaching in the Berman et al. reference in column 13, line 50, through column 14, line 10, and Figure 2 thereof. The Official Action indicates that the Berman et al. reference describes a display that allows a user to select tracks for recording. However, the Berman et al. reference does not disclose or even suggest a display means that initially indicates a track that was not previously recorded as being selected for recording by a recording means from a first recording medium to a second recording medium, as variously recited in Claims 1, 3, and 4 of the present application. The Berman et al. reference does not determine whether a track was downloaded

previously or not, and therefore cannot initially indicate such a track as being selected for recording. The Berman et al. reference relies solely upon the user to manually select tracks for downloading. Thus, since no check is made regarding whether any particular track was previously downloaded or not, the user of the Berman et al. reference could easily and mistakenly download the same track multiple times (and be charged multiple times for that track).

The Official Action suggests that the modification of the teaching in the Berman et al. reference to include the above features, and the combination of the modified Berman et al. invention with the Ichimura et al. reference would have been obvious because "[t]he motivation for doing so would be to display all information regarding the operational status of the apparatus in a user-friendly manner," citing to column 8, lines 1-5, of the Ichimura et al. reference and column 3, lines 55-60, of the Berman et al. reference. However, the Applicants submit that this broad, generic statement of a motivation does not provide any real teaching that would have motivated one of skill in the art to make the improvements to the Ichimura et al. reference and the Berman et al. reference as is being suggested, and could be erroneously used as a motivation for the teaching of almost any patentable improvement to the Ichimura et al. reference and the Berman et al. reference. Additionally, the portions of the references cited for such a motivational teaching do not appear to provide any such motivation. For example, column 8, lines 1-5, of the Ichimura et al. reference merely states "[o]nly main portions of the reproducing apparatus are shown in the reproducing apparatus 10 and the recording apparatus 20 in FIG. 1. Actually, an operation unit for user's operation and a display unit for displaying an operation status to a user are provided." Additionally,

column 3, lines 55-60, of the Berman et al. reference merely states that "[t]he playback unit includes a user interface and display component, which presents an easy-to-use interface that simulates playback controls that might be found on a conventional player such as a CD player or DAT player." Neither statement provides a motivation to modify the Berman et al. reference and combine it with the Ichimura et al. reference to arrive at an advantageous display means that initially indicates a track that was not previously recorded as being selected for recording by a recording means from a first recording medium to a second recording medium, as variously recited in Claims 1, 3, and 4 of the present application.

The Applicants, therefore, respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, the Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent

Claims 1, 3, and 4. Thus, the Applicants respectfully request the withdrawal of the art rejections of Claims 1, 3, and 4.

The cited references, either when taken singularly or in combination, fail to disclose or even suggest a selecting means, a selecting step, or code for selecting that initially, automatically selects portions of the contents of the first recording medium for recording that do not have recorded history information present in the apparatus, as recited in Claims 14, 18, and 22 of the present application. Regarding these features, which were incorporated from Claims 16, 20, and 24, the Official Action cites the Ichimura et al. reference for the teaching of such features and cites column 16, lines 15-25, and column 22, lines 5-15, of the Ichimura et al. reference for this teaching. (See Page 6 of the Official Action.) These portions of the Ichimura et al. reference do not teach an initial automatic selection of portions of content for recording that do not have recorded history information. To the contrary, the Ichimura et al. reference suggests that the initial selection of content for recording is based solely upon actions of a user. (See, e.g., column 15, lines 59-62.) Only after the reproducing operation begins does the apparatus in the Ichimura et al. reference check the copy management data (CMD) to determine whether in fact the copying operation will be carried out. (See column 16, lines 15-34.) The Ichimura et al. reference does not teach the initial automatic selection of certain portions of content for recording, but rather describes an apparatus that is capable of allowing or inhibiting the copying of content after the recording process has begun.

Accordingly, the Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations recited in independent

Claims 14, 18, and 22. Thus, the Applicants respectfully request the withdrawal of the art rejections of Claims 14, 18, and 22.

The dependent claims are considered allowable for the reasons advanced for the respective independent claim from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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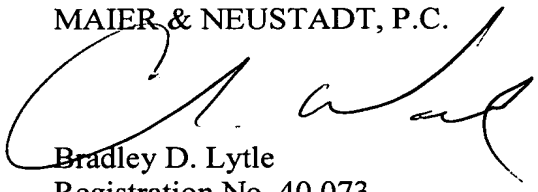

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